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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,194	11/21/2001	Kathy Maida-Smith	2416-00200	1306
23505 7590 04/14/2011 CONLEY ROSE, P.C. David A. Rose P. O. BOX 3267 HOUSTON, TX 77253-3267				
EXAMINER MIZRAHI, DIANE D				
ART UNIT		PAPER NUMBER		
2617				
NOTIFICATION DATE		DELIVERY MODE		
04/14/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

pathou@conleyrose.com

Office Action Summary

Application No.

09/990,194

Applicant(s)

MAIDA-SMITH ET AL.

Examiner

DIANE MIZRAHI

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2-1-11 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information "Is/Is Not" Statement(s) (PTO/SF/*)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____
- Paper No(s)/Mail Date ____

DETAILED ACTION

Claims 1-26 are pending. This office action is a response to a petition decision under 37 CFR 1.137(b) to revive the application.

Specification

The specification is objected to for failing to provide proper antecedent basis for the claimed subject matter of Claims 7-26. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).

Claims 7-26 of the originally filed specification recites, “**compilation system**”. There is no mention of an “**compilation system**” in the original specification. Appropriate correction is required.

Claim Objections

Claims 5,6,8,11-18,20, and 22 are objected to for the following:

In regards to Claims 5,6,8,11-18,20, and 22:

The claimed limitation, "wherein" raises a question as to the limiting effect of the language. The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326,

1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005) MPEP 2111.04 [R-3]. The Examiner will give the claim the broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Appropriate correction is required.

MPEP 2106 (II C) states "the subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language *that suggests or makes optional* but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim language. The following examples of language that may raise a question as to limiting effect of the language in a claim:

- A. statements of intended use of field or use,
- B. "adapted to" or "adapted for" clauses,
- C. "wherein" clauses,
- D. "whereby" clauses.

This list of examples is not intended to be exhaustive. See also MPEP 2111.04." Since "wherein" suggests or make optional the limitations following the claim language, Applicant is hereby advised that these limitations may not be given weight in future office actions.

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. in Hoffer v. Microsoft Corp., 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "whereby" clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." id. However, the court noted (quoting Minton v. Nat '1 Ass'n of Securities Dealers, Inc., 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620

(Fed. Cir. 2003)) that a "whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited," Id. See MPEP 211 t.03 17.

Regarding Claims 14 and 23 are objected to because the claim(s) recite, **"if" statements**. Since the limitation of "executing" is recited in the alternative (claim language suggests that the **"compares"** may or may not take place. Any functionality followed by the phrase **"if a match is found"** does not hold patentable weight. Appropriate corrections are required

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed non-statutory subject matter.

A § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process under § 101 and should be rejected as being directed to nonstatutory subject matter.

As to claims 1-6, and 19-26 these claims recited purely mental steps. These claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. As such, they fail to tie with a statutory category. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Claims 7-18 recite an "**system**" comprising a "**a first network component... a second network component....a data parser**".

The Examiner notes the disclosure of the present invention expressly states "*the compilation system is Figure 1.*"

see Specification -- Page 6).

The Examiner interprets **all functions** described herein **may be performed** in either hardware or **software**. Thus, for purposes of examination, the examiner interprets the recited "determining unit and the recited "**system**" to comprise only computer software.

Accordingly, the "system " recited in Claims 7-18 are software per se.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant recites, "network security data compilation system and associated method". Examiner is unclear as to what exactly is this particular claimed, "network security data compilation system and associated method". Further explanation is required.

Allowable Subject Matter

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure [see USPTO 892]:

Claims 1-26 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101 and 112, 2nd paragraph, set forth in this Office action.

The following is an examiner's statement of reasons for allowance:

Interpreting the claims in light of the specification, Examiner finds the claimed invention is patentably distinct from the prior art of record, which sets forth in the following: the prior art of record does not teach the combination of claimed elements including and under the broadest reasonable interpretation of the claimed limitation consistence with the Applicant's Specification.

The prior art cited above fails to teach all of the Applicant's claimed limitation. In particular, the claimed invention advantageously provides a finer level of detail that includes compiling parser scripts each corresponding to the structure of security data received from a network component which includes identifying sets of data categories, each set corresponding to security data received, from one of a plurality of network components, constructing database record definitions, each defining a record subdivided in accordance with one of the sets of data categories, and writing parser scripts that receive security data from the network components in combination with the other limitations of the claims, was not disclosed by, would not have been obvious over, nor would have been fairly suggested by the prior art of record in context to the claims and the specification.

It is noted, *PATENTS ARE RELEVANT AS PRIOR ART FOR ALL THEY CONTAIN* "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including non-preferred embodiments (see MPEP 2123).

It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. (See MPEP 2123.)

All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. See *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane D. Mizrahi whose telephone number is 571-272-4079. The examiner can normally be reached on Monday-Thursday (8:30 - 4:30 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Corsaro can be reached on (571) 272-7876. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 305-3900 for After Final communication.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the
Electronic Business Center (EBC) at 866-217-9197 (toll free).

/Diane Mizrahi/

Diane.Mizrahi@USPTO.gov
Primary Patent Examiner

April 6, 2011